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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nanao U.S.A. Corporation

Serial No. 74/319,375

John A. Hughes of Townsend and Townsend and Crew LLP for Nanao
U.S.A. Corporation.

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Before Cissel, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Nanao U.S.A. Corporation has filed an application to
register the mark "FLEXCOLOR" for "cathode ray tube (CRT)
monitors for computers and television sets."¹

Following publication and issuance of a notice of
allowance for such mark and goods, applicant submitted a timely
statement of use which alleges dates of first use for the goods

¹ Ser. No. 74/319,375, filed on October 2, 1992, which alleges a bona
fide intention to use the mark in commerce.

set forth in the notice of allowance of November 1, 1994. The specimens accompanying the statement of use, however, show use of the mark for a "Calibrator," specifically, a "Display Color Calibrator". Because "[t]he specimens do not show use of the mark for any goods identified in the statement of use," the Examining Attorney has required that "applicant ... submit three specimens showing use of the mark for the goods specified."²

Applicant, in response, submitted a proposed amendment to identify the goods in its application as a "calibrator assembly for use with cathode ray tube (CRT), in monitors and television sets". In its accompanying remarks, applicant maintains that "substitute specimens are no longer required" because the specimens submitted with the statement of use show use of the mark "FLEXCOLOR" for the goods set forth in the proposed amendment.³

² The Examining Attorney, in connection therewith, also required that applicant "verify, with an affidavit or declaration, ... that the substitute specimens were in use in commerce prior to the expiration of the time allowed to the applicant for filing a statement of use."

³ Curiously, applicant offered no corresponding amendment to its statement of use, which consequently continues to identify its goods as set forth in the notice of allowance, namely, "cathode ray tube (CRT) monitors for computers and television sets". Trademark Rule 2.88(i)(1) provides, however, that "[t]he goods or services specified in a statement of use must conform to those goods or services identified in the notice of allowance" and recommends, to avoid the problem presently faced by applicant, that "[a]n applicant may specify the goods or services [in the statement of use] by stating 'those goods or services identified in the notice of allowance' or, if appropriate, 'those goods or services identified in the notice of allowance except * * *' followed by an identification of the goods or services to be deleted." Nevertheless, for purposes of this appeal, we will assume that applicant intends to delete all goods identified in the notice of allowance except for, arguably, a "calibrator assembly for use with cathode ray tube (CRT), in monitors and television sets," thereby conforming the goods identified in the

Registration has been finally refused under Section 1(d)(1) of the Trademark Act, 15 U.S.C. §1051(d)(1), on the ground that applicant has failed to comply with the requirement that it "submit substitute specimens showing use of the mark for [the] goods specified" "in the notice of allowance and in the statement of use as originally filed". Specifically, in this regard, the Examining Attorney further states in her final refusal that (**emphasis added**):

The specimens are unacceptable as evidence of actual **service** mark use because they do not show use of the mark in commerce on **goods** identified in the notice of allowance. The applicant's [proposed] amendment to its identification of **goods** clause is an unacceptable resolution to the requirement that the applicant submit acceptable specimens.

Applicant has appealed. Briefs have been filed,⁴ but an oral hearing was not requested. We affirm the refusal to register.

Applicant, correctly noting that when filing a statement of use, the application may be amended to delete items

statement of use to those identified in the proposed amendment to the application.

⁴ While applicant, in its brief, accurately observes, among other things, that the final refusal states that the specimens are unacceptable as evidence of actual "service" mark use when, in fact, its application involves goods and thus seeks to register a trademark, the Examining Attorney, in her brief, reasonably notes that it is clear from the context of the final refusal that registration has been refused because the specimens fail to show actual trademark use for the goods set forth in the application and that, accordingly, the word "service" is simply a typographical error.

or to limit the identification of goods or services,⁵ argues that:

The Notice of Allowance for this application identified Applicant's goods as "cathode ray tubes [sic] (CRT) monitors for computers and television sets." In [its] Amendment of September 18, 1995 Applicant amended this identification of goods to: "calibrator assembly for use with cathode ray tubes [sic] (CRT)[,] in monitors and televisions [sic] sets." The calibrator assembly for CRT's is a subset of the general category of CRT's. As such, the proposed Amendment is a limitation of the identification of goods in the Notice of Allowance, which is expressly permitted by the rules. The Amendment should therefore be allowed. If so, the submitted specimens would be acceptable. No substitute specimens or Declaration were therefore necessary. The Statement of Use therefore should have been accepted, and the Application passed to registration.

Nothing in the advertising literature submitted with applicant's statement of use,⁶ however, supports applicant's assertion that "[t]he calibrator assembly for CRT's is a subset of the general

⁵ Although Trademark Rule 2.88(c) states, in pertinent part, that "[t]he statement of use may be filed only when the applicant has made use of the mark in commerce on or in connection with all of the goods or services, as specified in the notice of allowance, for which applicant will seek registration in that application, unless the statement of use is accompanied by a request in accordance with § 2.87 to divide out from the application the goods or services to which the statement of use pertains," Trademark Rule 2.88(f) provides, in relevant part, that "[t]he statement of use may be amended in accordance with §§ 2.59 and 2.71 through 2.75." In particular, Trademark Rule 2.71(b) specifies that "[t]he identification of goods or services may be amended to clarify the identification, but additions will not be permitted."

⁶ Applicant's statement of use also included copies of what appear to be packaging for applicant's calibrators. In view thereof, the Examining Attorney was careful to state in her brief that "the specimens of record are [otherwise] acceptable because they show use of the mark on boxes in which the goods are shipped."

category of CRT's."⁷ In fact, applicant's advertising brochures, which describe various models and features of its display monitors, make no mention of either a "calibrator assembly" or the mark "FLEXCOLOR". Instead, such literature makes references only to applicant's "FLAT SCREEN CRT MONITORS," which it offers under the "FlexScan" mark; its "Flexible Scanning Intelligent Color Monitor"; and its "FlexScan® Monitor Family". None of such products, however, is a calibrator assembly or "Display Color Calibrator" as shown on the specimens submitted with the statement of use.

The Examining Attorney maintains that applicant's proposed amendment does not obviate the requirement for substitute specimens since, contrary to applicant's assertion that a "calibrator assembly for use with cathode ray tube (CRT) in monitors for computers and television sets" is a "subset" of "cathode ray tube (CRT) monitors for computers and television sets," the former is outside the scope of the latter. As such, the Examining Attorney contends that applicant's proposed amendment of the identification of goods is an impermissible addition, rather than a clarification or limitation, and thus verified substitute specimens are necessary.

⁷ We judicially notice, for instance, that The American Heritage Dictionary of the English Language (3rd ed. 1992) at 1791 defines "subset" as "[a] set contained within a set" and at 1651 defines "set," in relevant part, as "1. A group of things of the same kind that belong together and are so used: a *chess set*." Thus, it is clear that, in ordinary parlance, a calibrator assembly is simply not a category, type or "subset" of cathode ray tubes.

In particular, while conceding that if the Board "finds that applicant's proposed amendment to the identification of goods clause is permissible, then the specimens of record are acceptable," the Examining Attorney urges that "[c]alibrators and display color calibrators," which are the goods described by the specimens, "are not logically within the scope of the original identification." In this regard, the Examining Attorney asserts that a cathode ray tube is defined in the Dictionary of Computer Words (1995) at 37 as "[t]he basic element in standard computer monitors and television sets" and in Spenser's Illustrated Computer Dictionary (1995) at 61 as "the picture tube of the standard computer display screen."⁸ The Examining Attorney, however, also points out that "[t]he record does not include any information as to the nature of a calibrator assembly, nor has the examining attorney found an authoritative definition outside the record as to the nature of this item." Nevertheless, she insists that the requirement for verified substitute specimens is proper because:

⁸ Inasmuch as the Board may properly take judicial notice of dictionary definitions, including definitions in technical reference works, we have considered the above definitions, which were set forth by the Examining Attorney for the first time in her brief. See, e.g., In re Hartop & Brandes, 311 F.2d 249, 135 USPQ 419, 423 (CCPA 1962); Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Furthermore, while we note that the definition from the Dictionary of Computer Words is accurate, the definition from Spencer's Illustrated Computer Dictionary set forth above actually pertains to the definition of the acronym "CRT," with the terminology "cathode ray tube (CRT)" being defined in such publication at 43 as an "[e]lectronic tube with a screen upon which information may be displayed."

[C]athode ray tubes and calibrator assemblies are different items; and ... the proposed amendment is a substitution of the goods which does not include goods that are logically within the scope of the identification. Because the applicant's proposed amendment to the identification of goods clause is a substitution of goods, because it does not clarify or limit those goods identified in the notice of allowance and statement of use [as originally filed], and because acceptance of the amendment would necessitate reexamination of the application and republication of the mark for opposition, it

is not, therefore, an acceptable amendment to the instant application

While, like the Examining Attorney, we have been unable to find an authoritative definition of a calibrator assembly, the following definitions of "calibration," "calibrate" and "assembly" nevertheless tend to shed some light on the nature and use of a calibrator assembly:⁹

(i) "**CALIBRATION**," which Van Nostrand's Scientific Encyclopedia (8th ed. 1995) at 507 discusses by noting that, "[w]ith reference to industrial and scientific instruments, the Instrument Society of America defines *calibrate* as follows: ... 2. To adjust the output of a device, to bring it to a desired value, within a specified tolerance, for a particular value of the input ...";

(ii) "**calibration**," which the IBM Dictionary of Computing (1994) at 82 defines as "[t]he adjustment of a piece of equipment

⁹ We also judicially notice, in this regard, that The Computer Desktop Encyclopedia (1996) at 553 sets forth a definition of "monitor calibrator" as "[a] hand-held device that is placed over the screen of a monitor and 'reads' the colors."

so that it meets normal operational standards ...";

(iii) "**calibrate**," which The American Heritage Dictionary of Science (1986) at 84 sets forth as meaning "to determine, check, or adjust the scale of (a thermometer, gauge, or other measuring instrument). Calibrating is usually done by comparison with a standard instrument";

(iii) "**calibrate**," which the McGraw-Hill Dictionary of Scientific & Technical Terms (3rd ed. 1984) at 238 lists as meaning "[t]o determine, by measurement or comparison with a standard, the correct value of each scale reading on a meter or other device, or the correct value for each setting of a control knob"; and

(iv) "**assembly**," which the McGraw-Hill Dictionary of Scientific & Technical Terms (3rd ed. 1984) at 113 defines as "[a] unit containing the component parts of a mechanism, machine or similar device.

In addition, we judicially notice the following definitions of "cathode ray tube (CRT)," "CRT" and "monitor," which have a bearing on the nature and use of applicant's goods, both as identified in the notice of allowance and as set forth in the proposed amendment:

(i) "**cathode ray tube (CRT)**," which Que's Computer User's Dictionary (5th ed. 1994) at 80 describes as connoting, "[i]n a computer monitor, a vacuum tube that uses an electron gun (cathode) to emit a beam of electrons that illuminates phosphors on-screen as the beam sweeps across the screen repeatedly. The computer monitor is often called a CRT. The same technology is used in television. See *monitor* ...";

(ii) "**CRT**," which The Computer Desktop Encyclopedia (1996) at 183 sets forth as

connoting "(Cathode Ray Tube) A vacuum tube used as a display screen in a video terminal or TV. The term often refers to the entire monitor rather than just the tube itself. Years ago, CRT was the popular term for the display screen. Today, monitor is the preferred term See ... *monitor*";

(iii) "**CRT**," which The Dictionary of Computer Graphics & Virtual Reality (2nd ed. 1995) at 30 lists as meaning "Cathode Ray Tube; common element for displays, using a beam of electrons, electrostatically or electromagnetically deflected, to excite a phosphor on the inner surface of a glass faceplate of an evacuated tube. The CRT is one element of a *CRT display* or *monitor* also having a case, chassis, power supply, and control electronics";

(iv) "**monitor**," which Que's Computer User's Dictionary (5th ed. 1994) at 320

defines as "[t]he complete device that produces an on-screen display, including all necessary internal support circuitry. A monitor is also called a *video display unit* (VDU) or *cathode-ray tube* (CRT)";

(v) "**monitor**," which The Computer Desktop Encyclopedia (1996) at 553 sets forth as connoting "[a] display screen used to present output from a computer, camera, VCR or other video generator"; and

(vi) "**monitor**," which the Dictionary of Computer Words (1995) at 179 lists as meaning "[t]he *display screen* of a computer and the case in which it is contained."

We agree with the Examining Attorney that substitute specimens are necessary inasmuch as the proposed amendment, which identifies applicant's goods as a "calibrator assembly for use with cathode ray tube (CRT), in monitors and television sets," amounts to a substitution, rather than a clarification or

limitation, of the goods as set forth in the notice of allowance, namely, "cathode ray tube (CRT) monitors for computers and television sets". Contrary to applicant's unsupported assertions that the former is a "subset" of the latter,¹⁰ a "calibrator assembly" for use with cathode ray tube computer monitors and television sets is, on its face, a different item which is not encompassed by the language "cathode ray tube monitors for computers and television sets" listed in the notice of allowance. Simply stated, the specimens, applicant's advertising literature and the dictionary definitions make it plain that a calibrator assembly is not a monitor; rather, it is a product or assembly utilized to calibrate a monitor. As such, the former is outside the scope of the latter. Thus, specimens showing use of the mark

¹⁰ Although not argued by applicant, there is nothing in the record which indicates that applicant's calibrator assembly is sold as a component of its cathode ray tube monitors for computers and television sets, nor is such clear from the language of the proposed amendment to the identification of goods. TMEP Section 804.08(b), which is entitled "Goods Which Are Components or Ingredients," provides in relevant part that:

When a mark is used to identify only a component or ingredient of a product, and not the entire product, the identification should precisely set forth the component or ingredient. In other words, when it is clearly indicated by the specimens or other material in the record that the mark relates only to a distinguishable part, component or ingredient of a composite or finished product, then the application should precisely describe that component or ingredient as the goods so that there will be no doubt that the mark refers only to one part and not the entire product.

Here, however, the specimens submitted with the statement of use show that the mark "FLEXCOLOR" pertains to a separate product, namely, a "Display Color Calibrator," and that such a calibrator assembly is not sold as a component of any of applicant's cathode ray tube monitors for computers and television sets.

"FLEXCOLOR" for a display color calibrator assembly are not acceptable; instead, substitute specimens demonstrating use of such mark for cathode ray tube (CRT) monitors for computers and television sets are required.

Decision: The refusal to register under Section 1(d)(1), in view of the failure to comply with the requirement for verified substitute specimens, is affirmed.

R. F. Cissel

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board